

Attorney Docket No. STINN-001-US
Application No. 10/725,083

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 7-14 are presently active in this case. The present Amendment amends independent Claim 7 and dependent claim 13, and adds new independent Claim 14. The above amendment shows the amended claims in marked up form for the Examiner's convenience.

Applicants wish to thank the Examiner for the courtesy of an interview granted to Applicants' representative on June 8, 2006, at which time the outstanding issues in this case were discussed. Arguments similar to the ones developed hereinafter were presented and the Examiner indicated that in light of the arguments, the amended claims overcome the cited prior art and he would reconsider the outstanding grounds for rejection upon formal submission of a response. Specifically, the Examiner and Applicant's representatives agreed that the proposed new claims define over the applied prior art and that the proposed new claims are subject to further search and consideration.

In the outstanding Office Action, Claims 7-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over McGlew et al. (U.S. Patent No. 6,164,824) in view of Freeman (U.S. Patent No. 5,209,573) and in further view of Herrington (U.S. Patent No. 4,913,560).

In response to the rejection(s) of Claims 7-13 under 35 U.S.C. 103(a), Applicants respectfully request reconsideration of these rejections and traverse the rejections in light of the new amendments, as discussed next.

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35 U.S.C. §103(a) Rejections

The McGlew patent, however, fails to teach or suggest Applicants' claimed folding of the combined sheets in an alternating pattern into a folded bunch having a centerline of the combined sheet in the middle of the folded bunch. In particular, and as acknowledged by the outstanding Office Action,¹ the McGlew patent fails to teach or suggest the claimed heat sealing along alternate folds along the bottom.

The outstanding Office Action rejects Applicants' Claim 7 based on the proposition that the Freeman patent discloses the above feature², and that it would have been obvious to modify the McGlew device by importing this feature from the Freeman patent to arrive at Applicants' claimed invention. Applicants respectfully submit, however, that the Freeman patent fails to disclose the above feature related to heat sealing of alternate folds of combined sheets into a folded bunch and having a centerline of the combined sheets in the middle of the folded bunch.

The outstanding Office Action relies on the Freeman patent's Fig. 3 and text in col. 3, lines 30-40. This passage of the Freeman patent recites "first and second folds 20, 22 are made as the opposing edges of the tube are folded inwardly. The tube is then folded along its center line 24." Reading the Freeman patent, a person of ordinary skill in the art would understand that a fold is disposed at an end of the folded bunch, as shown in Fig. 3. Accordingly, the folded bunch in the Freeman patent is *not* a folded bunch having a centerline of the combined sheet in the middle of the folded bunch as would be required to meet Applicants' claimed feature. Therefore, even if the

¹ See outstanding Office Action at page 3.

² See outstanding Office Action from page 3.

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combination of the McGlew and Freeman patents is assumed to be proper, the combination fails to teach every element of the claimed invention. Specifically, the combination fails to teach the claimed folded bunch having a centerline of the combined sheet in the middle of the folded bunch. Accordingly, Applicants respectfully traverse, and request reconsideration of, this rejection based on these patents.³

Applicants respectfully further traverse the rejection because there is no sufficient evidence of record for the required motivation to modify the McGlew device by incorporating Freeman's garbage bag having a heat seal along alternate folds of the edges of plastic sheets about 50mm from the top of the combined sheets for the following reasons.⁴

The outstanding Office Action states that the proposed modification would have been obvious "as taught to be a known equivalent sealing means."⁵ The record, however, fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such modification. While the Freeman patent may provide a reason for heat sealing two plastic sheets, the Freeman patent fails to suggest why a person of ordinary skill in the art would be motivated heat seal two plastic sheets in a device such as the one disclosed in the McGlew patent, which is designed to prevent slippage of a garbage bag into a trash container. In particular, the Freeman patent

³ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

⁴ See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

⁵ See outstanding Office Action at page 4.

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states that its heat seal already achieves Freeman's goal of providing a trash can liner which is substantially leak-proof.⁶ The Freeman patent states that the sealed end of the bag 10 is effective in distributing forces in many directions, thereby increasing the effectiveness of the bag under wet load testing.⁷ The Freeman patent does not suggest that an additional feature is needed to achieve its intended goal. In particular, the Freeman patent does not suggest that sealing the top 50mm of the combined sheet are folded in an alternating pattern into a folded bunch having a centerline of the combined sheet in the middle of the folded bunch, such as the one disclosed in the McGlew patent, would be desired.

Similarly, the McGlew patent states that its structure already achieves the goal of preventing the slippage of a garbage bag down into a trash basket or can as the plastic container is being filled.⁸ The McGlew patent does not suggest that further improvement is desired, nor that another feature should be added to further improve the ability of the McGlew device to prevent slippage of the bag into a trash container. In particular, the McGlew patent does not suggest to add heat seals, such as those disclosed in the Freeman patent. The McGlew and Freeman patents, therefore, do not provide the motivation to perform the proposed modification of the McGlew device. In other words, an attempt to bring in the isolated teaching of Freeman's heat seals into the McGlew device would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.⁹

⁶ See the Secondary patent, for example, at column 1, lines 48-49.

⁷ See the Secondary patent, for example, at column 3, lines 10-15.

⁸ See the Primary patent, for example, at column 1, lines 40-42.

⁹ See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the

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While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record. In this case, there is nothing in the record supporting the Office Action's proposed modification of the McGlew patent.

Furthermore, it is not clear from the record how the citation of Freeman's sealing the top 50mm of the combined sheet are folded in an alternating pattern into a folded bunch having a centerline of the combined sheet in the middle of the folded bunch could be incorporated into the McGlew device. Under such a modification, the trash bag would have to be sealed 50mm from a bottom portion, rendering the bottom 50mm incapable of holding trash. Such modification would require a substantial reconstruction or redesign of the elements of the McGlew device, and/or would change the basic principle of operation of the McGlew device insofar as the McGlew device would no longer be able to hold a desired volume of trash. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.¹⁰ Furthermore, it is not clear from the record whether such modification would actually form the bottom edge from a heat seal of alternate folds that could be used as a handle.

Additionally, it is not clear from the record how the citation of Herrington's heat sealed edges of a bag having a sticky bag tie closure could be incorporated into the McGlew device. Under such a modification, the sticky tape disposed around the opening of the bag of Herrington, as stated in col. 3, lines 10-20, would be combined

isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

¹⁰ See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

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with the elastic band of McGlew. Such modification would require a substantial reconstruction or redesign of the elements of the McGlew device, and/or would change the basic principle of operation of the McGlew device insofar as the McGlew device would expose the sticky tape as soon as the bag onto which the tape was disposed was stretched around a container and held securely in place using the elastic band of McGlew. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.¹¹

In rejecting a claim under 35 U.S.C. 103(a), the USPTO must support its rejection by "substantial evidence" within the record,¹² and by "clear and particular" evidence¹³ of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying the McGlew device by incorporating Freeman's heat seal at a bottom portion of the bag. Without such motivation and absent improper hindsight reconstruction,¹⁴ a person of ordinary skill in the art would not be motivated to perform the proposed modification, and independent

¹¹ See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

¹² *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

¹³ *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." (emphasis added).)

¹⁴ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

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Claim 7 and dependent claims 8-13 are believed to be non-obvious and patentable over the applied prior art.

CONCLUSION

As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. §103, the present amendment places the application in better form for reconsideration and allowance.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 7-13 as well as for new claim 14, which recites similar limitations to independent claim 7, is earnestly sought.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.


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To the extent necessary, a petition for an extension of time under 37 C.F.R.
1.136 is hereby made.

With best regards,

Very truly yours,

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